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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,151	12/26/2001	Johanna Fraki	442-010769-US(PAR)	8146
2512	7590	02/12/2004	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER

3679

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/033,151

Applicant(s)

FRAKI ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26, 29, 30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 29, 30 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings were received on 12/8/03. These drawings are acceptable.

### ***Election/Restrictions***

Applicant's election with traverse of group I and species 1C in Paper No. 8 is acknowledged. The traversal is on the ground(s) that claims 29 and 30 are various aspects of the invention with claims in different categories; these claims define functions similar to claim 1 and have similar limitations; and the user is the same in the claims. This is not found persuasive because claim 1 is a method claim comprised of steps or procedures, which do not have functions or intent of use. Applicant has stated that the user is the same to all groups. Applicant is respectfully reminded that the computer program product or the cellular mobile phone, as respectively claimed in claims 29 and 30, is not required in the method and the user is not claimed as part of the computer program or the cellular mobile phone. The cellular mobile phone in the system of claim 21 does not require the particulars of the cellular mobile phone as claimed in claim 30. Furthermore, applicant is correct in that the groups are in different categories. It is for this reason the restriction was made as the inventions are in different categories.

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The requirement is still deemed proper and is therefore made FINAL.

Claim 32 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and being dependant from withdrawn claim 30, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 9-12, 14-21, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Filler et al.), WO00/11827, in view of Yu et al., 6,684,087.

Regarding claim 1, Filler et al. disclose a method comprising:

identify a user of a computer (page 9, line 29) in a communication network (normally a computer is identified via an ethernet address, an user's ID or password in a service provider), the user enters the communication network using the computer (users are known to enter an internet through the computer); and

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associate a digital collectible card with the user based on an identification received from the computer (page 2, lines 17-20; page 15, lines 28-32). However, the communication network is not a cellular mobile communication network and the computer is not a cellular mobile phone. Yu et al. disclose a computer being a mobile cellular phone to enter a cellular mobile communication network and use the internet to download digital collectible cards as an alternative to trading data over wired connections. Therefore, as taught by Yu et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cellular mobile phone in a cellular mobile communication network to enter the internet, as an alternative to wired communication, and download digital collectible cards.

Regarding claim 2, Filler et al. teach the user trading the card with a second user (page 27, lines 12-15). The second user becomes associated with the card after the trade (pg. 27, lines 35-36).

Regarding claim 3, Filler et al., teach trading the card being performed under control of a server (pg. 27, line 15-34).

Regarding claim 5, Filler et al. teach the method further includes storing the card on a server and associating the card with the user being made at the server (pg 15, line 28 - pg. 16, line 5).

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Regarding claim 6, Filler et al. teach associating indicates ownership of the card by the user.

Regarding claim 7, Filler et al. teach the method further includes notify the user of a given digital collectible card associated with a second user. The given collectible card is available for purchase or trade (pg. 27, line 20-22).

Regarding claim 9, Filler et al. teach the method further includes requesting to purchase the card before associating the card with the user (pg. 13, lines 30-31).

Regarding claim 10, Filler et al. teach entering an additional password at the mobile terminal (pg. 15, line 31-33). Applicant is reminded that a previous password has not been defined in claim 1 to render an additional password in claim 10.

Regarding claim 11, Filler et al., as modified above, teach the method further includes transmit a request from the cellular mobile phone to a server to send the card to the mobile phone; identify the user sending the request; compare the identity of the user with the user identification information associated with the card; and, provide the card to the user in response to matching the identity and the user identification information (pg. 15, lines 28 - pg. 16, line 5).

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Regarding claim 12, Filler et al. teach providing the card to the user comprises transmit the card from the server to the mobile phone via the communication network; and, displaying the card on the mobile phone.

Regarding claims 14 and 25, Filler et al. teach the card includes at least one of a streamed video, an advertisement, digital music, a video clip (pg. 6, lines 9-15) and an avatar feature.

Regarding claims 15 and 26, Filler et al. teach the card includes at least one dynamic user-specific feature (pg. 2, lines 4-6).

Regarding claim 16, Filler et al. teach the card comprises data information (pg. 6, line 11), and the method further comprises updating data information of the card in real time based on a real event corresponding to contents of the card (col. 2, lines 6-11).

Regarding claim 17, Filler et al. teach updating data information of the card being done on request of the user (pg. 25, 2-8). Applicant is reminded that the information is accessible by a link upon being clicked by a user.

Regarding claim 18, the method further comprises adding an indicator including a certain price for the card (pg. 2, line 12-14).

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Regarding claim 19, Filler et al., as modified above, teaches the communication network includes a cellular mobile communication network.

Regarding claim 20, the server stores digital collectible cards and association information identifying owners of the cards (pg. 9, line 3-4).

Regarding claim 21, Filler et al. disclose a digital collectible card system in a communication network comprising the communication network, at least one computer, and a server communicating with the computer via the communication network. However, the communication network is not a cellular mobile communication network or the computer is a mobile cellular phone. Yu et al. teach a mobile cellular phone in a cellular mobile communication network as an alternative setup to transfer data between devices in wireless connections versus wired connections. Therefore, as taught by Yu et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mobile cellular phone in the cellular communication network as wireless connection instead of a wired connection.

Considering the modification, the phone is capable of displaying and controlling of at least one digital collectible card associated with a user of the mobile phone. The server is capable of storing the card and associating the user with the card. Associating is based on an identification of the user in the mobile network received from the phone.



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Regarding claim 23, as modified above, Yu et al. teach the communication network including mobile network and internet. The mobile network is selected from a group consisting of GSM, GPRS, and UMTS.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 2 above, and further in view of Beuk et al., 5,774,673.

Regarding claim 4, Filler et al., as modified above, teaches trading the card with the second user includes storing the digital card at a first mobile terminal and transferring the card from the first mobile terminal to a second mobile terminal. However, trading is not transferred via a wireless communication. Beuk et al. teach in Figure 1 trading data between a first device and a second device via a wireless communication (infrared communication) to communicate and share files wirelessly. Therefore, as taught by Beuk et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to transfer the digital cards between two cellular mobile phones via a wireless communication to trade the cards.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 11 above, and further in view of Peppel, 6,200,216.

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Regarding claim 13, Filler et al., as modified above, fails to disclose providing the user with the digital collectible card comprises providing the card for view on the mobile terminal for a limited period of time only. Peppel teaches, on column 6, in lines 29-37, providing the card for view on the mobile terminal for a limited period of time only to generate scarcity of the cards. Therefore, as taught by Peppel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the card to the user for a limited period of time only to generate scarcity of the cards.

Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as respectively applied to claims 1 and 21 above, and further in view of Treyz et al., 6,587,835.

Regarding claim 8, applicant is reminded that cellular communication networks keep location information of the phones including the phone of the user in the network as taught by Filler et al. in the modification above. However, Filler et al., as modified above, fails to determine vicinity of a second user based on the location information of the mobile phone of the user and of the mobile phone of the second user. Treyz et al. teach determining vicinity of a second user based on location information of a mobile phone of a user and of a mobile phone of a second user to find proximity of the second user with respect to the user (col. 45, lines 21-30). Therefore, as taught by Treyz et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine vicinity of a second user based on the location information of

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the mobile phone of the user and of the mobile phone of the second user to find the proximity of the second user with respect to the user.

Regarding claim 24, given the method in claim 8 above, the cellular communication network requires a location register to locate the position of the cellular phone. Therefore, as taught by Treyz et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a location register in the cellular communication network to determine vicinity information of a second cell phone user from a first cell phone user.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 21 above, and further in view of Atsmon et al., 6,607,136.

Regarding claim 22, Filler et al., as modified above, fails to disclose the system further including a digital physical card wirelessly communicating with the cellular phone. Atsmon et al., 6,607,136, teach in Figure 1 a system further including a digital physical card **10** wirelessly communicating with a device **14**. However, the device as shown in Figure 1 is a computer instead of a cellular mobile phone. Atsmon et al. suggests that the device 14 can be a cellular phone to make a sale transaction without the need of a smart card reader (col. 2, lines 34-38). Therefore, as taught by Atsmon et al., it would have been obvious to one of ordinary skill in the art at the time the invention

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was made to include the digital physical card wirelessly communicating with the cell phone in Yu et al. to make a sales transaction without the need of the smart card reader. Applicant is reminded that a computer, a PDA, a laptop computer, and a cellular phone are equivalent devices that function as a computer and the physical card is capable of presenting the digital collectible card transferred thereto independently of the cellular phone.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 8, 11, 16 and 20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or

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relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

**Lynne H. Browne**  
**Supervisory Patent Examiner**  
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E.G.

February 5, 2004



**Anthony Knight**  
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